

### **REMARKS**

Applicants submit this Reply in response to the non-final Office Action mailed September 8, 2008. Claims 29-56 are currently pending, of which claims 29, 42, 55, and 56 are independent. By this response, Applicants have amended claims 42, 44, 50, 55, and 56. In the non-final Office Action, the Examiner rejected claims 29-37, 42-50, 55, and 56 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,842,863 ("Fox et al."). The Examiner rejected claims 38 and 51 under 35 U.S.C. § 103(a) as being unpatentable over Fox et al. in view of U.S. Patent No. 4,964,164 ("Fiat"). The Examiner rejected claims 39-41 and 52-54 under 35 U.S.C. § 103(a) as being unpatentable over Fox et al. in view of U.S. Patent Application Publication No. 2003/0115457 ("Wildish et al."). Applicants respectfully traverse the pending claim rejections for at least the reasons set forth below.<sup>1</sup>

#### **Rejections Under 35 U.S.C. § 102(e)**

Applicants respectfully traverse the Section 102(e) rejections of claims 29-37, 42-50, 55, and 56. In order to properly establish an anticipation rejection under 35 U.S.C. § 102, every element of the claims at issue must be found in the applied prior-art reference, either expressly or under principles of inherency. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). In this case, Fox et al. fails to teach or suggest every element of Applicants' inventions.

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the Applicants' disclosure, including the claims, and the related art. Regardless of whether any such statement is specifically addressed herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Applicants' representative independent claim 29 calls for a combination including, for example, "configuring said originator device not to send a new item toward said recipient device in the absence of a respective digitally signed receipt for a previously sent item." Applicants respectfully submit that Fox et al. fails to disclose or suggest at least an originator device that is configured "not to send a new item toward said recipient device in the absence of a respective digitally signed receipt for a previously sent item," as recited in independent claim 29.

Fox et al. discloses "certificate reissuance for checking the status of a certificate in financial transactions." Fox et al., Title. According to Fox et al., a certificate "may serve as a receipt, including an accumulated record of the signatures (digital certificates) and policy applied throughout the financial transaction." Fox et al., Abstract; *see also id.*, col. 10, ll. 43-47. Fox et al. further discloses that "each transfer of the transaction forms a digitally-signed chain of evidence recording each step of the transaction and policy applied thereto." *Id.* In this manner, "[e]ven after the transaction terminates and no longer exists, the receipts persist and continue to provide evidence [of every step of the transaction and policy applied thereto]." Fox et al., col. 9, ll. 58-59. Fox et al. does not disclose or suggest any restrictions on when a party to the transaction can send a new item relative to when that same party receives a receipt for a previously-transmitted item.

As explained above, Fox et al. discloses a multi-step financial transaction in which a receipt is generated at each step of the transaction. *See, e.g., Fox et al.*, FIGS. 2, 3, 5, and 6. While Fox et al. generally discloses a separate receipt for each step of the transaction, Fox et al. fails to disclose or suggest any conditions on when a

party to the transaction can send a new item relative to receiving a receipt for a previously sent item. The part of Fox et al. cited by the Examiner, i.e., column 10, lines 48-58, is devoid of such teachings. See September 8, 2008, Office Action at 3. Fox et al. appears to be completely silent regarding any requirement that a party must first receive a receipt for a previously sent item before it can send a new item in the multi-step transaction. For at least this reason, Applicants submit that Fox et al. fails to disclose or suggest at least an originator device that is configured “not to send a new item . . . . in the absence of a respective digitally signed receipt for a previously sent item,” as claimed.

Applicants’ amended independent claims 42, 55, and 56, although different in scope from independent claim 29, recite similar subject matter and are therefore allowable for at least the same reasons. Dependent claims 30-37 and 43-50 depend on independent claims 29 and 42 and are also allowable for at least the same reasons.

#### **Rejections Under 35 U.S.C. § 103(a)**

The Examiner rejected dependent claims 38-41 and 51-54 for being unpatentable under 35 U.S.C. § 103(a) over Fox et al. in combination with other cited art. Notwithstanding any teachings of Fiat or Wildish et al. relative to the subject matter recited in dependent claims 38-41 and 51-54, these pending dependent claims depend on independent claims 29 or 42 and are therefore allowable for at least the same reasons discussed above with reference to the pending 35 U.S.C. § 102(e) rejections.

#### **Conclusion**

The preceding remarks are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not

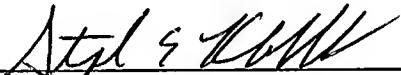
addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other possible bases of patentability.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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